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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,140	11/24/2003	JIMMY WU	11413-US-PA	1139
31561	7590	02/24/2005	EXAMINER	
JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE 7 FLOOR-1, NO. 100 ROOSEVELT ROAD, SECTION 2 TAIPEI, 100 TAIWAN				SINGH, RAMNANDAN P
ART UNIT		PAPER NUMBER		
		2644		
DATE MAILED: 02/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/707,140	WU ET AL.	
	Examiner Ramnandan Singh	Art Unit 2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 November 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
6) <input type="checkbox"/> Other: _____. |
|--|--|

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of the priority document in Chinese has been filed on April 30, 2004.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Claim 8 recites the limitation "the insulation system (105) comprises a plurality of phototransistors" in lines 2-3. The "phototransistors" for the insulation system (105) are not shown. Therefore, the phototransistors must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the switch device" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Laturell [US 20040052242 A1].

Regarding claim 1, Laturell teaches a dialing circuit apparatus incorporating an Internet Protocol (IP) phone and a plain Old Phone Service (POTS) phone shown in Fig. 10, comprising:

- an IP phone system (i.e. broadband access network 130) for activating an IP phone (1020) according to an IP phone number;
 - a POTS phone system (140) for activating a POTS phone (1040) according to a POTS phone number;
 - an insulation system comprising a POTS/VoBB gateway 1065 and a cross-connect element 1085, electrically connected between the IP phone system (130) and the POTS phone system (140) for insulating the IP phone system from the POTS system; and
 - a key panel control (i.e. state/command interpreter (SCI) 1070) connected to the IP phone system and the POTS phone system;
- wherein when the city power is on and a second phone number having a first format of the POTS phone number is inputted from the key panel, the second phone number is transferred by the insulating system and used as the POTS phone number to active the POTS phone, and the IP phone is disabled (i.e. XCE 1085);
- wherein when the city power is off and a third phone number having a second format of the POTS phone number is inputted from the key panel, the IP phone is

turned off without a power supply from the city power, and the third phone number is used to active the POTS phone (see claims 7, 22) [Para: 0126; Para: 0002-0005; 0009-0011; 0013-0014; 0036-0038; 0059; 0102-0112]; claims 1-12] .

Regarding claim 2, Laturell further teaches the dialing circuit apparatus, wherein the key panel further comprises:

an IP phone keypad (1020) connected to the IP phone system 9130); and a POTS phone keypad (1040) connected to the POTS phone system; wherein the key panel (1070) is disposed above the IP phone keypad and the POTS phone keypad, wherein each key of the key panel is disposed above a key of the IP phone keypad and above a key of the POTS phone keypad, whereby when a phone number is inputted, the IP phone keypad and the POTS phone keypad receive the phone number respectively.

Regarding claim 3, Laturell further teaches the dialing circuit apparatus, wherein the first format of the POTS phone number is the same as the second format of the POTS phone number (i.e. when a city power is on).

Regarding claim 4, Laturell further teaches the dialing circuit apparatus, wherein the first format of the POTS phone number is different from the second format of the POTS phone number [when the city power is Off. Claim 7].

Regarding claim 5, the limitations are shown above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laturell as applied to claim 1 above, and further in view of Ahn et al [US 20030021261 A1] and further in view of Aponte te al [US 6,371,780 B1].

Regarding claim 6, although Laturell teaches the dialing circuit apparatus for the IP phone system including an insulation system comprising a gateway system 1065 and cross-connect element 1085 shown in Fig. 10 [Para. 0102; 0106; 0108; 0111], no details about the functional structure of the IP phone system including a logic converting unit and main control unit are disclosed. So one of the ordinary skill in the art would have been motivated to seek any known circuit of an internet gateway to fulfill such details, such as Ahu et al.

Ahu et al teach an IP gateway of the IP phone system comprising a logic converting unit (35) connected to the IP phone keypad for converting the phone number to an IP dialing data signal; a main control unit (21) connected to the logic converting

unit and an IP phone control unit connected to the main control unit for receiving the IP phone transmission signal and outputting an IP phone control signal [Figs. 2-4; Para: 0012-0013; 0015; 0035-0037; 0054; 0093].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the internet gateway of Ahu et al with Laturell to enable the design of the invention.

Further, the combination of Laturell and Ahu et al does not teach expressly using a RJ-45 jack for connecting the phone line. However, it is well-known in the art.

Aponte et al teach using a RJ-45 port wherein the RJ-45 is connected to a phone company and to the IP phone control unit via an IP phone interface for activating an IP phone by the IP phone control signal [Figs. 3-5, 9, 12; col. 5, lines 15-65; col. 3, lines 17-60; col. 7, lines 21-64].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the RJ-45 port of Aponte et al with the combine system of Ahu et al and Laturell to provide a robust functional way for users to evolve from telephony to IP phone systems [Aponte et al; col. 5, lines 23-28].

Claim 7 is essentially similar to claim 6 and is rejected for the reasons stated above.

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laturell as applied to claim 1 above, and further in view of Cassista et al [US 20020007459 A1].

Regarding claim 8, Regarding claim 6, although Laturell teaches the dialing circuit apparatus comprising the insulation system comprising a gateway system 1065 and cross-connect element 1085 shown in Fig. 10 [Para. 0102; 0106; 0108; 0111], no details about the structure of the insulation circuit system are disclosed. So one of the ordinary skill in the art would have been motivated to seek any known circuit to insulate the circuit connection, such as Cassista et al.

Cassista et al not teach expressly the dialing circuit apparatus wherein the insulation system comprises a phototransistor circuit [Fig. 2; Para. 0055; 0113].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the phototransistor circuit of Cassista et al with Laturell to enable the design of the invention.

Regarding claim 9 , Cassista et al teach a switch device comprising a plurality of transistors [Fig. 6; Para: 0109].

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (i) Philips et al [US 20040176085 A1] teach a demarcation device that can serve as an insulator between different transport media [Figs. 2A, 4, 6; Para: 0039]; and
- (ii) Chen et al [US 20030086559 A1] teach a fallback function telecommunications device [Figs. 1-8; Abstract; Para: 0019].

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (703)308-6270. The examiner can normally be reached on M-F(8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester Isen can be reached on (703)-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh
Examiner
Art Unit 2644




SINH TRAN
SUPERVISORY PATENT EXAMINER